The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 28

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JOHANNES F.M. D'ACHARD

Appeal No. 2002-1068
Application 09/022,132

ON BRIEF

Before COHEN, STAAB, and McQUADE, Administrative Patent Judges.

MCQUADE, Administrative Patent Judge.

DECISION ON APPEAL

Johannes F. M. D'Achard appeals from the final rejection of claims 1 through 4 and 6 through 9, all of the claims pending in the application.[1]

This is the second decision rendered in this appeal. We vacated the first decision (Paper No. 24) upon learning that a reply brief (Paper No. 25) timely filed by the appellant was not in the record, and hence not taken into account, during our previous deliberations (see Paper No. 27). As will become

[1] Claims 1 and 6 have been amended subsequent to final rejection.

evident below, the reply brief has not persuaded us to change our position on the merits of the appeal.

THE INVENTION

The invention relates to "[a] method for operating a video game with backfeeding a video image of a player, and a video game arranged for practising the method" (specification, page 1). Representative claims 1 and 6 read as follows:

1. A method for operating a multi-player video game, the method comprising:
enabling each player of multiple players to interact with a gaming environment,
machine-detecting a score and/or performance of each player in a particular session of the video game,
backfeeding into the gaming environment a video image of a currently high-scoring player, and
displaying the gaming environment, and the video image of the currently high-scoring player of the multiple players in a prominent location, during the particular session of the video game.

6. A video game system being arranged for running a multi-player video gaming environment, comprising
a user interface that is configured to enable each player of multiple players to interact with the gaming environment,
a detector that is configured to detect a score and/or performance of each player during a particular session of the video game,
a backfeeding device that is configured to:
backfeed into the gaming environment a video image of a currently high-scoring player of the multiple players, and
a display that is configured to display the gaming environment, and the video image of the currently high-scoring player in a relatively prominent position, during the particular session of the video game, and
one or more cameras that are configured to provide the video image of each player.

THE PRIOR ART

The references relied on by the examiner to support the final rejection are:

Sitrick	4,521,014	Jun. 4, 1985
Breslow et al. (Breslow)	4,710,873	Dec. 1, 1987
Hogan et al. (Hogan)	5,657,246	Aug. 12, 1997
Weiss	5,821,983	Oct. 13, 1998

THE REJECTIONS

Claims 1 through 4 and 6 through 8 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sitrick in view of Breslow.

Claim 9 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Sitrick in view of Breslow and either Hogan or Weiss.

Attention is directed to the appellant's main and reply briefs (Paper Nos. 22 and 25) and to the final rejection and examiner's answer (Paper Nos. 18 and 23) for the respective positions of the appellant and the examiner with regard to the merits of these rejections.[2]

---

[2] In the final rejection, claims 1 and 6 also stood rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. The examiner has since withdrawn this rejection (see page 2 in the answer) in light of the amendment subsequent to final rejection (see n.1, supra). In addition, the apparently

DISCUSSION

I. Grouping of claims

For purposes of the appeal, the claims at bar shall stand or fall in accordance with the statement in the appellant's brief that "Claims 1 and 6 stand alone. Claims 2-4 and 9 stand or fall together with Claim 1. Claims 7 and 8 stand or fall together with Claim 6" (page 4).

II. The merits

Sitrick, the examiner's primary reference, discloses "a distributed game system comprising a plurality of video game apparatus, selectively interlinkable to form a homogenous single identity game system" (column 1, lines 20 through 23). Each apparatus includes a user console comprising a joy stick 100, a communications switch 105, a keyboard 110, a speaker/microphone 130 and a display 140. Within the context of a multi-user game system, the user consoles communicate with a master controller 3000 (see Figure 2C and column 4, line 53 et seq.). Of particular interest is Sitrick's teaching that

> the video game can be made more personal and exciting by utilizing actual video imagery created responsive to user inputs at the individual game apparatus. . . .

---

inadvertent failure of the brief to acknowledge the above rejection of dependent claim 9 is of no practical moment given the overall position taken by the appellant in the appeal.

> . . . The video game system has a video image input means, 200 of FIG. 1B, which provides the necessary hardware to input and digitize a visual image of the user of the individual game apparatus 1000.
> . . .
> The user created visual display, either of the user or of the user created visual imagery, can then represent that user in the video game audiovisual presentation, either for the stand-alone game, or for a multiuser video game. Thus, the user can create his or her own spacecraft, race car, or other preselected character functions (e.g., subimage identifier segments) which can then be incorporated into the overall video game audiovisual presentation in combination with a predefined set of complimentary audiovisual imagery segments according to a predefined set of game rules [column 11, lines 2 through 51].

It is not disputed Sitrick responds to all of the limitations in independent claims 1 and 6 except for those relating to the backfeed and display of the video image of the currently high-scoring player.

Breslow discloses a video game apparatus and method wherein the image of a player is incorporated into the game as an interactive enhancement feature (see column 1, lines 10 through 68). As fairly summarized in Breslow's Abstract,

> [v]ideo game apparatus and method includes an arrangement for acquiring and storing data representing an image of the face of a game player or other entity and for selectively incorporating the image of the entity throughout the play of the game at predetermined locations on the video game display and in coordination with the video game graphics. In accordance with the play of the various games controlled by the video game apparatus, the stored image of one or more persons is utilized as the head of a video graphics generated

> body, as a portion of other generated graphics representations, as a functional game object representation, or as a controllable playing object. The video game apparatus also provides for the display of the game player image in a scoring display format wherein the images of a predetermined number of previous game players attaining the highest scores are displayed at the beginning or end of a play of the game.

In one illustrative game described by Breslow (see column 4, line 5 et seq.), a player, represented on the display by his/her facial image, competes against a number of game-controlled former champions represented on the display by their facial images.

The examiner seems to have taken two different approaches with respect to the proposed combination of Sitrick and Breslow offered in support of the appealed rejections. In the final rejection, the examiner concludes that it would have been obvious "to include the prominent display of the image data and high scorer information as taught by Breslow during the game of Sitrick, rather [than] at the beginning [or] end of the game, in order to indicate the leading player so that the competition is more realistic and exciting" (page 3). In the answer, the examiner characterizes Breslow's use during a game of the previous high-scoring champion's image as meeting the "currently high-scoring player" claim limitations at issue. Neither of these positions, however, is well founded.

To begin with, there is nothing in the combined teachings of Sitrick and Breslow which would have suggested including Breslow's display of previous players' high scores, expressly disclosed as being shown before or after a game, during the actual play of a game. In addition, Breslow's high-scoring player or champion from a previous game does not constitute a "currently high-scoring player" as set forth in claims 1 and 6 under any reasonable interpretation of this term considered in light of the context of the claims and the underlying disclosure.

Nonetheless, for reasons different than those advanced by the examiner, the combined teachings of Sitrick and Breslow do support a conclusion that the subject matter set forth in claims 1 and 6 would have been obvious within the meaning of § 103(a). Sitrick and Breslow collectively describe the use of a player's visual image to represent the player within the presentation of a game as an interactive enhancement feature which makes the game more personal and exciting. The teaching of these benefits would have provided the artisan with ample suggestion or motivation to utilize the visual images of the players in Sitrick's multi-player game as, for example, playing objects controlled by the respective players. This incorporation of the players' video images into the game would necessarily result in the backfeed and

display of the video image of the "currently high-scoring player," whomever that might be, within the gaming environment in a prominent location during the particular session of the game, and thus responds to the "currently high-scoring player" limitations recited in claims 1 and 6.

In light of the foregoing, we shall sustain the standing 35 U.S.C. § 103(a) rejections of independent claims 1 and 6, and dependent claims 2 through 4 and 7 through 9 which stand or fall therewith. Because the basic thrust of our reasoning differs from that advanced by the examiner, we designate the sustained rejections as new grounds of rejection under 37 CFR § 1.196(b) to allow the appellant a fair opportunity to react thereto (see In re Kronig, 539 F.2d 1300, 1302-03, 190 USPQ 425, 426-27 (CCPA 1976)).

SUMMARY

The decision of the examiner to reject claims 1 through 4 and 6 through 9 is affirmed, with the affirmance designated as a new ground of rejection under 37 CFR § 1.196(b).

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b)(amended effective Dec. 1, 1997, by final rule notice, 62 Fed. Reg. 53,131, 53,197 (Oct. 10, 1997), 1203 Off. Gaz. Pat. & Trademark Office 63, 122 (Oct. 21, 1997)). 37 CFR

§ 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

> (1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

AFFIRMED; 37 CFR § 1.196(b).

IRWIN CHARLES COHEN)
Administrative Patent Judge)
)
) BOARD OF PATENT
)
LAWRENCE J. STAAB) APPEALS AND
Administrative Patent Judge)
) INTERFERENCES
)
JOHN P. McQUADE)
Administrative Patent Judge)

JPM/kis

Appeal No. 2002-1068
Application 09/022,132

CORPORATE PATENT COUNSEL
U.S. PHILIPS CORPORATION
580 WHITE PLAINS ROAD
TARRYTOWN, NY 10591